

REMARKS

Claims 11, 13-17, 19 and 20 are pending.

Applicants' undersigned representative thanks Examiners Del Sole and Stewart for the courtesies extended during the telephone interview of July 6, 2010. Applicants' separate record of the substance of the Interview is incorporated in the remarks below.

Applicants' Response to the Claim Rejections under 35 U.S.C. §103(a)

Claims 11, 13-16 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiga et al. (EP 1,536,543, using 2006/0103253 for citation purposes), in view of Osada et al. (US 5,435,953).

In response thereto, applicants respectfully submit that the combination of references does not render the current invention as now claimed obvious for at least the reason that all the features of the claims are not provided for, nor is there any rationale prompting a skilled artisan to modify the combination so as to derive the present invention.

Specifically, as discussed during the interview, there is no manner whereby a skilled artisan could be prompted to modify the formation of Shiga in such a manner so as to provide for at least the features of parent claim 11 that the resin reservoir pots provided in the upper die vertically penetrate the upper die; and the resin reservoir pots in the upper die are in a region radially inward of and different from positions of the magnet insertion holes as viewed from a top thereof, and the liquefied resin material is supplied to the magnet insertion holes from the resin reservoir pots through resin passages formed on an under surface of the upper die.

As noted during the interview, referring to the possible embodiment of the current invention pursuant to Figs.2 and 3 of the application, the reservoir pots 50 are formed in the upper die 37 and resin flows through the pots 50 to passages 51 located in the upper die 37 so as to seal magnets 47 in a motor core 36.

Contrarily, as discussed during the interview, the primary reference, Shiga describes a formation process allotted for the joining of not only the magnets 19 but the frame 17 also to a core 18. As described in paragraph [0040], Figs. 8A and 8B of Shiga, magnets 19, frame 17 and core 18 are all placed between upper 32b and lower 32a dies. Thereafter, resin is inserted through a cavity 34 so as to seal the magnets 19, core 18 and frame 17 in one setting. See also paragraph [0041].

As established under U.S. patent law, the results of a combination of references cannot render the prior art unsatisfactory for its intended purpose or destroy the function thereof. See M.P.E.P. §2143.01.V and VI.

At section 13 on page 5 of the Office Action, the reasons as to why a skilled artisan would utilize a configuration wherein the reservoir pots vertically penetrate the upper die in Shiga based on Osada and Sera are: (1) for the benefit of having flexibility as to where the resin pots can be placed; (2) so the resin can expand and force out unwanted air and moisture; or (3) for the benefit of being able to be pressed by a plunger and forced out through runners and gates into the cavities. The reasons for the combination are taken from col. 7, lines 35-47 of Osada which relates to upward movement of the resin from the lower mold. However, as noted during

the interview, vertical penetration of the upper die does not increase flexibility of placement of the reservoir pots.

Moreover, as noted above, the combination cannot substantially interfere with the intended function of the prior art. Specifically, as noted in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), the court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352. Cited at M.P.E.P. §2143.01.

In the current instance, as noted and agreed during the Interview, Shiga teaches a specific formation process so as to allow for the joining of the core 18, frame 17 and magnets 19. This described process is central to the teachings of Shiga which teaches the placement of resin in the cavity 34 between the upper 32b and lower 32a dies. A skilled artisan would have no manner whereby they could combine the teachings of the secondary reference Osada as to the formation of the reservoir pots without having to redesign the device and process of Shiga or remove the intended function of the process of Shiga of joining the frame 17, magnets 19 and core 18 with a single resin setting.

Wherefore, applicants respectfully request favourable reconsideration on the basis that a skilled artisan could not derive the present invention based upon the combination of Shiga and Osada. Specifically, a skilled artisan could not arrive at the use of the reservoir pots in the upper die and the passages in the upper die within the formation process of Shiga.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiga et al. in view of Osada et al. as applied to claim 11, and further in view of Sera.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiga et al. in view of Osada as applied to claim 11 above, and further in view of Venrooij.

Applicants respectfully submit that by addressing the rejection of parent claim 11, as detailed above, likewise the rejection of claims 17 and 20 are addressed by nature of their dependency.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

Application No. 10/584,922
Art Unit: 1791

Request under 37 C.F.R. §1.116
Attorney Docket No. 062663

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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